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PATENT
Attorney Docket No. 320400-00004

IN THE U.S. PATENT AND TRADEMARK OFFICE

Application No.: 10/617,477
Filing Date: July 11, 2003
Inventor(s): Steven Roy Lipscomb
Group Art Unit: 3712
Examiner Name: Collins, Delores R.
Customer No.: 27160

Title: Game Table with Integral Lighting System

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date.

17 Sept 2004

Date

John S. Paniaguas
John S. Paniaguas
Registration No. 31,051
Attorney for Applicant(s)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF DECISION ON PETITION

A Petition to Make Special was filed in the above-identified case on August 13, 2004.

By copy of a paper mailed on September 7, 2004 the Petition was dismissed. The basis for the dismissal is that the Declaration submitted lacked the required statements as set forth in paragraphs (A)-(C) set forth in MPEP § 708.02(II).

Paragraph 708.02 (II) (A)-(C) are repeated below for the convenience of the Examiner.

“(A) that there is an actual infringing device or product actually on the market or method in use:

That a rigid comparison of the alleged infringing device, product or method with the claims of the application has been made, and that in his or her opinion, some of the claims are unquestionably infringed; and

(C) that he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.”

Each of these assertions was made in the attached Declaration as pointed out below. Moreover, the undersigned is respectfully restating the allegations with respect to each of the paragraphs (A)-(C).

With respect to paragraph (A), paragraph 3 of the Declaration states: “In my opinion, claim 1, as amended, is infringed by a third-party method. Implicit in that statement is that the third-party method is in use. However, the undersigned positively alleges, based on evidence reviewed, that the third-party method is actually in use and infringes at least one claim in the above-identified patent application.

With respect to paragraph (B), as mentioned above, paragraph 3 of the Declaration, submitted together with the Petition to Make Special, indicated that claim 1, in the opinion of the undersigned, is infringed. It is respectfully submitted that conclusions regarding infringement require comparison of the alleged infringing method with the claim of the application. Although not specifically alleged, such a comparison is implicit in a conclusion of infringement. Notwithstanding, the undersigned hereby alleges that a comparison of the alleged method and the claims in the above-identified application has been made. Based on that comparison, it is respectfully submitted that some of the claims, as amended, are unquestionably infringed.

Regarding paragraph (C), an Information Disclosure Statement, along with cited references, were enclosed with the Petition to Make Special. This Information Disclosure Statement was submitted pursuant to 37 C.F.R. §§ 1.56, 1.97, and 1.98. Paragraph 4 of the Declaration also states that the claims are patentable over those references. Implicit in that statement is the undersigned’s knowledge of the pertinent prior art. Notwithstanding, the

undersigned hereby positively alleges that a search of the prior art was made and was considered by the undersigned prior to filing the Petition to Make Special.

The second to last paragraph of the Petition indicates that the Petition does not stay the period for filing a reply to the outstanding Office Action. However, it is respectfully submitted that a reply to the outstanding Office Action was filed on August 13, 2004, along with the Petition to Make Special. A copy of our stamped receipt indicating the filing of the Amendment is enclosed. Also enclosed is another copy of the Amendment and Transmittal. Thus, it is respectfully submitted that the response was filed on August 13, 2004.

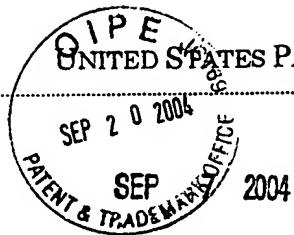
The Examiner is respectfully requested to reconsider and grant the above-mentioned Petition.

Respectfully submitted,

KATTEN MUCHIN ZAVIS ROSENMAN

By: 
John S. Paniaguas
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Attorney for Applicant(s)

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Application of
Steven Roy Lipscomb et al
Application No. 10/617,477
Filed: July 11, 2003
Attorney Docket No. 320400-00004

: DECISION ON PETITION

:

This is a decision on the petition to make special filed on August 13, 2004. The petition is submitted pursuant to the practice established in MPEP § 708.02(II) "Infringement." The \$130.00 petition fee has allegedly been submitted in the form of a check, but Office records do not confirm this. The petition fee will be charged to Deposit Account No. 50-1214, and if ultimately there is a duplicate charge, petitioners may request a refund.

The petition is dismissed.

A review of the petition shows that petitioners allege that a declaration has been submitted in support of the allegation that an actual infringement exists warranting grant of the petition. However, the file does not appear to contain such declaration. Absent the declaration, the petition lacks the required statements (A)-(C) set forth in MPEP § 708.02(II).

Petitioners may file a renewed petition, perfecting the originally filed petition, without additional fee. Any renewed petition must be filed within two months of the date of this Decision. See 37 CFR 1.181(f).

It is noted that an Office action was promulgated on May 19, 2003. Petitioners are reminded that the filing of the instant petition or any renewed petition will not stay the period for filing a reply to the outstanding Office action. 37 CFR 1.181(f).

The application is being forwarded to the Head Supervisory Applications Examiner to charge the \$130.00 petition fee to Deposit Account No. 50-1214.

PETITION DISMISSED.

Stephen Marcus, Special Program Examiner,
Technology Center 3700

Patent Administrator
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JOHN S. PANIAGUAS
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August 12, 2004

VIA FEDERAL EXPRESS

Mr. Tony Castorina
Law Offices of A. J. Castorina
2001 Jefferson Davis Highway
Suite 207
Arlington, VA 22202



Re: "Game Table with Integral Lighting System"
Our File No. 320400-00004

Dear Tony:

We would like you to hand deliver a copy of the Petition to Make Special for the above-identified case. Please file these documents as soon as possible and provide us with a receipt indicating that the documents have been filed. Enclosed are copies of the following documents:

- Petition to Extend Time (two months)
- Check made payable to the "Commissioner for Patents" for \$210.00
- Information Disclosure Statement
- Copy of WO 02/32518
- Petition to Make Special
- Declaration by John S. Paniaguas
- Amendment and Transmittal

Mr. Tony Castorina
August 12, 2004
Page 2

If you have any questions, please do not hesitate to call.

Very truly yours,



John S. Paniaguas

JSP:jr:50211766

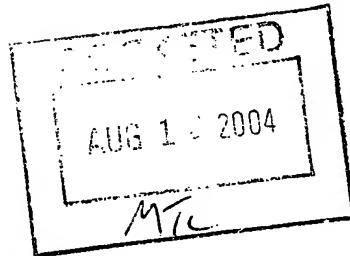
Enclosures



PATENT
Attorney Docket No. 320400-00004

THE U.S. PATENT AND TRADEMARK OFFICE

Application No.: 10/617,477)
Filing Date: July 11, 2003)
Inventor(s): Steven Roy Lipscomb)
Group Art Unit: 3712)
Examiner Name: Collins, Delores R.)
Customer No.: 27160)
Title: Game Table with Integral Lighting)
System)



Mail Stop Non-Fee Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

Sir:

Transmitted herewith is an amendment/reply in the above-identified application.

1. () A paper requesting correction/substitution of drawings is attached.
2. Fee for Claims

(X) No additional fee is required.

The fee for additional claims in accordance with 37 C.F.R. §1.16(b)-(d) has been calculated as shown below:

				SMALL ENTITY		OTHER THAN A SMALL ENTITY	
	Claims Remaining After Amendment	Highest No. Previously Paid for	Present Extra	Rate	Additional Fee	Rate	Additional Fee
Total	13	Minus	20	0	x 9	0	x 18
Indep.	1	Minus	3	0	X 43	0	x 86
Fee for Multiple Dependent Claims				+145	0	+290	--
TOTAL ADDITIONAL FEES				0	OR	-----	

3. **Method of Payment of Fees**

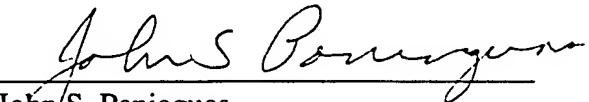
(Enclosed is our firm check in the amount of: \$
(Charge \$_____ to Deposit Account No. 50-1214.

4. () The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214. This sheet is filed in duplicate.

Respectfully Submitted,

August 12, 2004
(Date)

By:


John S. Paniaguas
Registration No. 31,051

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PATENT
Attorney Docket No. 320400-00004

IN THE U.S. PATENT AND TRADEMARK OFFICE

Application No.: 10/617,477)
Filing Date: July 11, 2003)
Inventor(s): Steven Roy Lipscomb)
Group Art Unit: 3712)
Examiner Name: Collins, Delores R.)
Customer No.: 27160)
Title: Game Table with Integral Lighting System)

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:

In response to the restriction requirement mailed on May 19, 2004, please enter the following Amendment.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 5 of this paper.

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims

Claim 1 (Currently Amended). A game table comprising:
a playing surface configured to be disposed at a predetermined height; and
a light window source disposed adjacent said playing surface; and
~~a light source disposed beneath said light window for projecting light upward.~~

Claim 2 (Currently Amended). The game table as recited in claim 1, wherein said playing surface defines one or more player stations and a dealer station and said light window source is disposed adjacent all of said one or more player stations.

Claim 3 (Currently Amended). The game table as recited in claim 2, further including a light trough rigidly secured to the underside of the playing surface for carrying a said light source, said light trough disposed at least partially beneath said a light window.

Claim 4 (Currently Amended). The game table as recited in claim 3, wherein said light window source is disposed such that it is continuous adjacent all of said player stations.

Claim 5 (Currently Amended). The game table as recited in claim 4, wherein said light window source is disposed adjacent an edge of said playing surface.

Claim 6 (Currently Amended). The game table as recited in claim 4, wherein said light window is flush with said playing surface.

Claim 7 (Currently Amended). The game table as recited in claim 1, further including an arm rest adjacent said light window around said player stations.

Claim 8 (Original). The game table as recited in claim 1, wherein said playing surface is configured for use in a poker tournament.

Claim 9 (Currently Amended). The game table as recited in claim 3, wherein said light trough source is configured with a generally C-shaped cross section defining a first and second vertical risers and a connecting floor C-shape.

Claim 10 (Currently Amended). The game table as recited in claim 9 3, wherein said trough includes a first vertical riser is securely fastened to the underside of the playing surface and located such that a portion of said light trough extends outwardly from an edge of said playing surface.

Claim 11 (Currently Amended). The game table as recited in claim 9 3, wherein said light trough is formed with one or more access holes.

Claim 12 (Currently Amended). The game table as recited in claim 9 3, wherein said light trough is formed with one or more vent holes.

Claim 13 (Original). The game table as recited in claim 1, wherein said light source includes one or more fluorescent or non-fluorescent lights.

Claim 14 (Currently Amended). The game table as recited in claim 4 3, wherein said light window is formed from plexiglass or other similar material.

Claim 15 (Canceled).

Claim 16 (Canceled).

Claim 17 (Canceled).

Claim 18 (Canceled).

Claim 19 (Canceled).

Claim 20 (Canceled).

Claim 21 (Cancelled).

REMARKS/ARGUMENTS

Upon entry of the instant Amendment, Claims 1-14 are pending. Claims 15-21 have been cancelled in response to the restriction requirement. This response is being filed in connection with a Petition to Make Special. The Examiner is respectfully requested to provide favorable consideration.

Respectfully submitted,

KATTEN MUCHIN ZAVIS ROSENMAN

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Attorney Docket No.: 320400-00004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lipscomb *et al.*)
 Application No.: 10/617,477)
 Title: Game Table With Integral Lighting)
 System)
 Filing Date: July 11, 2003)
 Group Art Unit: 3712)
 Examiner: Collins, Dolores R.)

Petition to Make Special
(37 CFR §1.102 and MPEP §708.02)

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Applicant hereby petitions under 37 CFR §1.102 and MPEP §708.02 to make the above-identified application special based on actual infringement of the pending claims in the above-identified patent application. Accompanying this Petition are the following:

- Declaration by John S. Paniaguas in Support of Petition to Make Special Because of Actual Infringement;
- Information Disclosure Statement;
- Form 1449; and
- Petition Fee.

Remarks

In accordance with MPEP §708-02, VIII, Applicant submits the following.

(A) Petition Fee

A check in the amount of \$130.00 as required under 37 CFR §1.17(h) is enclosed. Should it be determined that additional fees are required, the United States Patent and Trademark Office is hereby authorized to charge Deposit Account No. 50-1214 of the undersigned.

(B) Pre-Examination Search

The Applicant's attorneys discovered the following patents by way of an electronic database search.

5,451,054

4,719,545

6,016,389

6,435,698

US 2002/0123377

WO 02/32518 A1

In addition to the electronic database search, the following patents were discovered by a professional search firm.

3,802,708
3,926,439
5,653,640
5,791,758
5,876,262

(C) Copies of References

Pursuant to the Notice in the Official Gazette dated August 5, 2003, except for WO 02/32518 A1, copies of the balance of the references are not being submitted with the Information Disclosure Statement filed concurrently herewith, since the application is being filed after June 30, 2003 and the balance of the references consist of U.S. issued patents and a published U.S. patent application.

(D) Summary of the Invention

The present invention relates to a game table, for use in a poker game, for example, which includes an integral lighting system.

In support of the Petition to Make Special, the above-identified application, attached herewith is a Declaration by John S. Paniaguas in Support of Petition to Make Special. It is respectfully submitted that this declaration provide a sufficient showing of infringement as required as MPEP §708.02 II to support a favorable decision to make the above-identified application special.

Conclusion

Applicant respectfully submits that the Petition to Make Special together with the Declaration, Information Disclosure Statement, PTO Form 1449 and Petition Fee satisfy the requirements of 37 CFR §1.102 and MPEP §708.02 to make the above-identified application special. The Commissioner is hereby authorized to charge any additional fees which may be required by this petition to Deposit Account No. 50-1214.

Katten Muchin Zavis Rosenman

By: John S. Paniaguas
John S. Paniaguas
Registration No. 31,051

Date: 12 Aug 2004

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Attorney Docket No.: 320400-00004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lipscomb et al)
Application No.: 10/617,477)
Title: Game Table With Integral Lighting)
System)
Filing Date: July 11, 2003)
Group Art Unit: 3712)
Examiner: Collins, Dolores R.)

**Declaration by John S. Paniaguas in Support of
Petition to Make Special
(37 CFR §1.102 and MPEP §708.02)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, John S. Paniaguas, Registration Number 31,051, am an attorney of record for the Applicant in the above-identified application and make the following declarations:

1. I prepared and filed a provisional patent application No. 60/411,615, filed on September 18, 2002. This provisional application was converted to an utility patent application and filed on July 11, 2003.
2. The original utility patent application was filed with 21 claims. Of those 21 claims, a restriction requirement was issued on May 19, 2004, restricting the claims as follows :

Group I- Claims 1-20

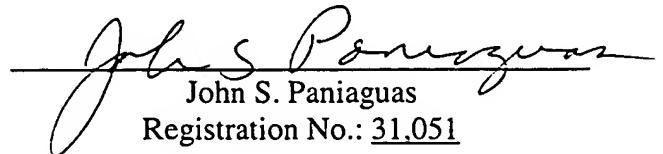
Group II- Claim 21

3. In response to the restriction requirement, a preliminary amendment is enclosed herewith electing Group I. Claims 15-21 have been cancelled so that all claims are directed to a single invention. It is respectfully submitted that at least claim 1, as amended, reads on a third party apparatus brought to my attention by the client. In my opinion claim 1, as amended, is infringed by the third party method.
4. I have reviewed the references submitted herewith and believe that none of the references disclose a method as recited in claim 1 or any of the dependent claims thereupon.. Accordingly, it is my opinion that all pending claims for the above-identified application are allowable over the references of record.
5. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1002 of Title 18 of the United States code, and that such willful false statement may jeopardize the validity of the application or any patent issued thereon.

FURTHER, DECLARANT SAIETH NOT.

IN WITNESS WHEREOF, I have signed, sealed and delivered this Declaration this 12th day of August, 2004.

KATTEN MUCHIN ZAVIS ROSENMAN


John S. Paniaguas
Registration No.: 31,051

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